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Supreme Court of the United States

OCTOBER TERM, 1944

No. 1100

RICHARD A. ENGLER,

Petitioner,

v.

GENERAL ELECTRIC COMPANY,

Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE CIR-
CUIT COURT OF APPEALS FOR THE SECOND
CIRCUIT AND BRIEF IN SUPPORT THEREOF.**

CARL E. RING,
Attorney for Petitioner.

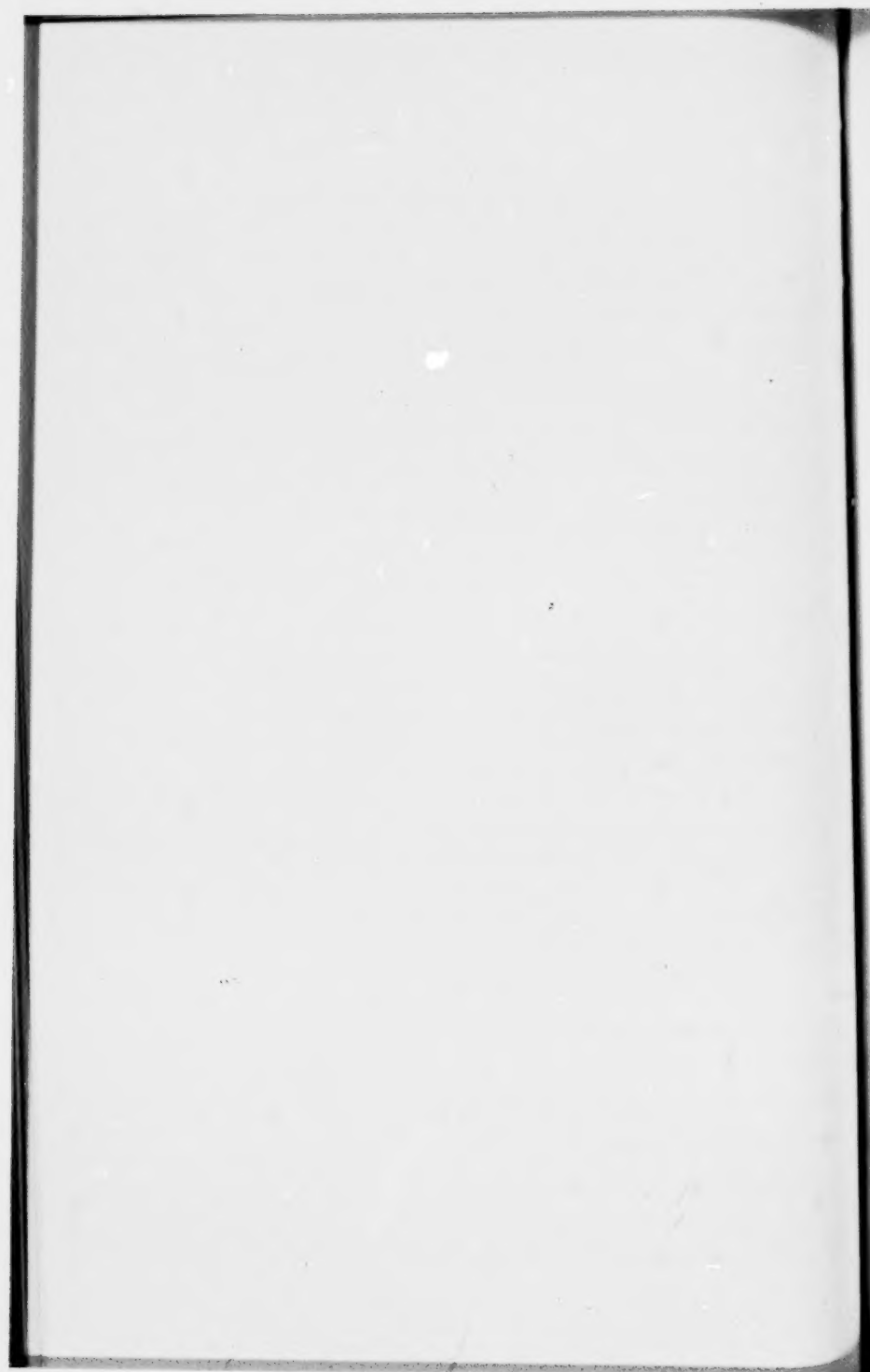


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OCTOBER TERM, 1944

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v.

GENERAL ELECTRIC COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI

To the Honorable, the Chief Justice and Associate Justices
of the SUPREME COURT OF THE UNITED STATES:

Your petitioner, Richard A. Engler, having been granted leave to prosecute this action in forma pauperis, by order of the District Court for the Southern District of New York and counsel having been duly appointed for petitioner by said court, prays for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit to review the decree of that Court in this cause filed January 4, 1945.

Summary Statement of the Matter Involved

This is a suit in equity by the petitioner in the Southern District of New York to recover damage for infringement of petitioners patent No. 1492972 issued May 6, 1924. The action was commenced in 1939 but was not tried until after counsel had been appointed for petitioner in 1941.

The District Court found petitioners patent not infringed, made no finding on validity of the patent and dismissed the complaint.

The Circuit Court of Appeals affirmed but there is not a strict concurrence of decision of both courts which would invoke the usual rule of this court to follow the lower courts as will appear hereinafter.

QUESTION INVOLVED

This Court has held in a long line of decisions that a combination patent may be valid, i.e., a combination of old elements combined in a new way to produce a new result. And, this court has repeatedly held that such a patent is infringed by a combination which omits one or more of the elements of ingredients of the combination—provided that each omitted element or ingredient is replaced by another which serves the same function in the combination *and was old and well known as such a substitute or equivalent before the date of invention or application for patent.*

In *Imhaeuser v. Buerk*, 101 U. S. 647, this court said:

“Patentees of an invention consisting merely of a combination of old ingredients are entitled to equivalents by which is meant that the patent in respect to each of the respective ingredients comprising the invention covers every other ingredient which in the same arrangement of the parts, will perform the same function, *if it was well known as a proper substitute for the one described in the specifications at the date of the patent.*”

Other cases are cited in the brief.

Petitioners case falls squarely within this rule. The District Court held that there was no equivalent notwithstanding that appellees own expert witness, a Harvard professor, testified to the contrary.

The Court of Appeals in its original opinion likewise held there was no equivalent. After the testimony of Pro-

fessor Dawes, appellees expert, was pointed out to the court on an application for rehearing the court denied rehearing but recognized the equivalent in fact and function. Nevertheless the court held that there could be no equivalent in law because the substantial element was old and well known prior to petitioners invention.

The Court of Appeals said:

“Thus the equivalency in function was recognized but we were unable to treat this as enough to come within the range of equivalents to which the patentee was entitled because, as we pointed out, what we called intermittent polarity *was old in the art*. We still are unable so to broaden the claim for the same reason, for whether the creation of poles of opposite value around the defendant’s armature ought to be called a reversal of polarity or *not it is nevertheless an old feature as to which the appellant could not, and did not, obtain any monopoly when his patent was granted. So he must be limited in his range of equivalents at least enough to exclude that.*”

Thus the Court of Appeals used as a ground for denying a favorable finding of equivalence and accordingly infringement the very fact which is the basis of a favorable rule as stated in the decisions of this court to wit: that the substituted element or ingredient was old and well known as a substitute to accomplish the same function prior to petitioners invention.*

Notwithstanding that petitioner had to go through a ten day trial and a long appeal and rehearing, this simple issue

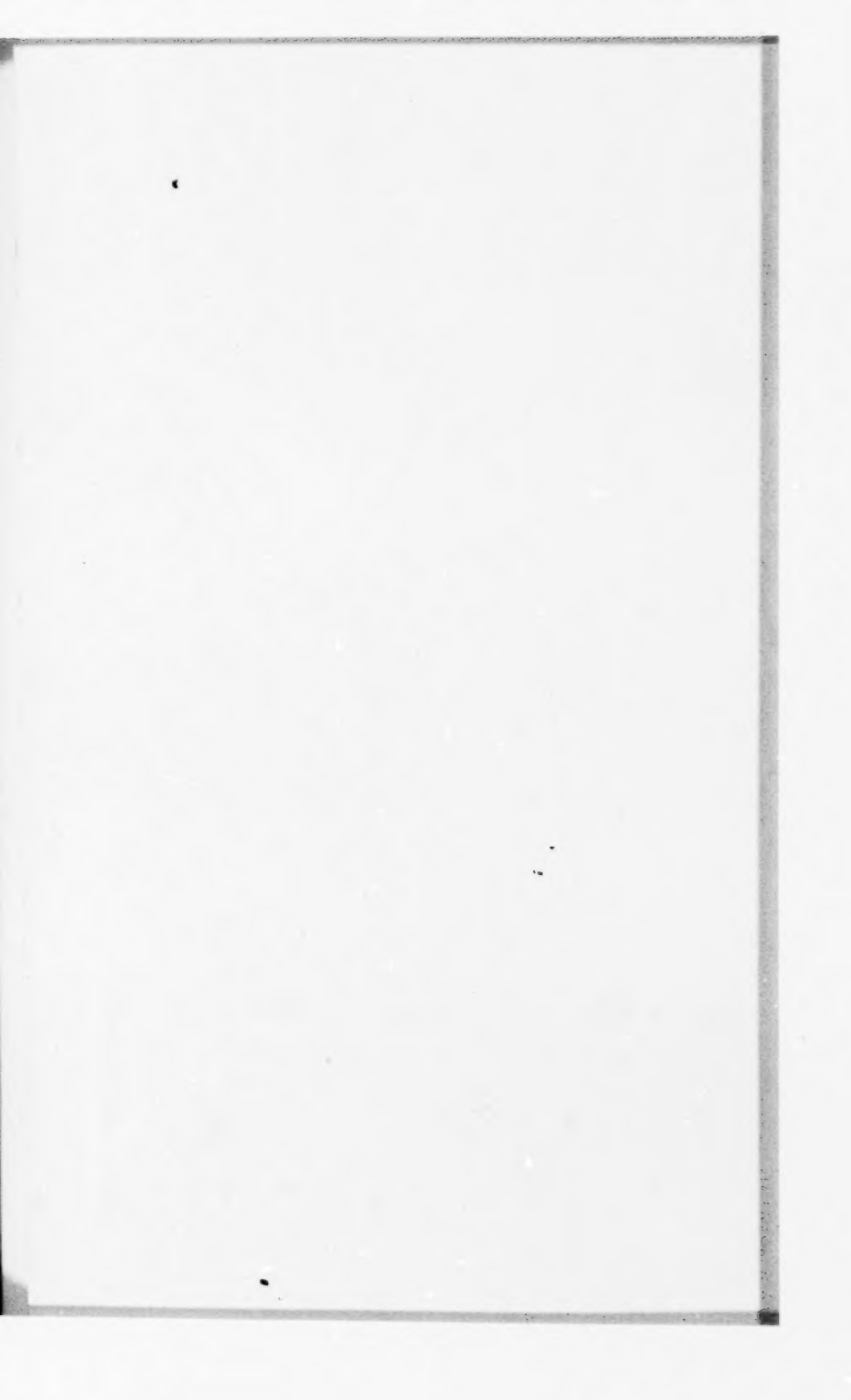
* The equivalent element was referred to as (5) in the Trial Court’s opinion. The Circuit Court of Appeals also said element (10) was omitted but the District Court opinion had pointed out that if the ruling on element (5) was favorable, a favorable ruling on (10) would have to follow. This is discussed in full in the accompanying brief.

is now and always has been the only issue on infringement in this case and the pre-trial order of Judge Knox so provided.

WHEREFORE, your petitioner respectfully prays for a writ of certiorari to be issued under the seal of this Court directed to the United States Court of Appeals for the Second Circuit, commanding said Court to certify and send to this Court on a day to be designated a true and complete transcript of the record and proceedings of the Circuit Court of Appeals had in that Court, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals to be reversed; and that petitioner be granted such other and further relief as may be proper.

RICHARD A. ENGLER.

New York City,
March 31, 1945.





BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I

Opinions Below

The opinion of the District Court Judge (Hon. Edward Conger) is published in 49 Fed. Supp. 782.

The original opinion of the Circuit Court of Appeals is published in 144 Fed. 2nd 191. The opinion of the Circuit Court of Appeals denying rehearing is published in 146 Fed. 2nd 723 and at page 21 herein.

II

Jurisdiction

The grounds of jurisdiction are:

(a) This writ is to review the decree of the Circuit Court of Appeals for the Second Circuit filed January 4, 1945 affirming a decree of dismissal in an action for infringement of United States Letters Patent.

(b) The statute under which jurisdiction is invoked is U. S. C. A., Title 28, Section 347; U. S. J. C. Section 240a as amended by the Act of February 13, 1925.

III

Statement of the Case

Petitioners patent related to a special type of electric motor called "homopolar." Petitioner never had sufficient funds to build one and never induced others to. There was little prior art on the subject. The respondent built one large and expensive motor which petitioner claimed to in-

fringe his patent while respondent claimed it was built under its later patents, later by ten years.

The District Court found as a conclusion of law that it was "not necessary on the issue of infringement to pass on the question of the "homopolarity" of either the Logan Motor (respondents motor) or the device contemplated by the Engler patent," having found that the element in issue was no equivalent.

The Court of Appeals disagreed with the District Court and found that both motors were homopolar.

The court also found that the elements in issue were in fact equivalents but denied a favorable ruling because the substituted element was old.

The District Court had in its opinion set forth claim eight of the petitioners patent as follows:

1. In an electric motor,
- 2 the combination with,
3. a plurality of power windings,
4. and a plurality of magnetic members,
5. of reversible polarity,
6. relatively rotatable,
7. and in mutually inductive relation,
8. of current supply for causing motion of said members relatively to said windings to produce useful work
9. means for reversing the polarity in a synchronous cycle
10. and means for rendering ineffective the electromotive force induced by said reversals

and said

“this leaves in dispute *elements 5, 9 and 10.

The Trial Courts opinion said:

“The plaintiff argues that cutting out an armature coil in the Logan Motor (respondents device) and cutting it in again a half revolution later is equivalent to Engler reversal (element 5). I have puzzled over this a great deal. I cannot see it. There is no reversal in the Logan Motor. The similarity, I find is the result accomplished in rotation. Of course this does not spell out infringement.”

Thus the District Court summarily disposed of the only real issue in the case without reference to the testimony.

The District Court accordingly found as Facts No. 13 and No. 14

13. “There is nothing in the Logan Motor equivalent to elements 5 and 9 of the Engler patent”.
14. “There is not present in the Logan Motor either specifically or by equivalents means for rendering ineffective the electromotive force induced by said reversals.” (element 10)

It is obvious that the case turns on the finding with respect to element 5 because if the corresponding element in respondents device is an equivalent then a favorable ruling must follow on 9 and 10.

In fact the District Court so ruled in its opinion and this ruling cannot be seriously challenged.

* The Court suggested a possible dispute of element 4 but called it unimportant. The respondents device had a single magnetic member used cyclically with each power winding, just as a six cylinder automobile could have a carbureter for each cylinder though in practice a single carbureter is used for all.

The Trial Court opinion had said

“Indeed the attorney for the plaintiff in summation before me stated in substance that if I found for the plaintiff on element 5, element 9 would follow and also element 10. *I agree with him.*”

The record substantiates this view. Since the only real controversy is with respect to element 5, elements 9 and 10 can be disposed of with a few words.

Element 9 is “means for reversing the polarity in a synchronous cycle.”

Petitioner showed that cutting certain coils out and cutting them in again at a later time in the respondents device, as hereinafter argued at length, was an equivalent of element 5. This was particularly established by the cross examination of Prof. Dawes, appellees expert witness.

Thereafter Dawes further testified with respect to element 9 as follows:

Q. If under the law the cutting out of coil 2 and putting it back in again at a later period is an equivalent to reversing the field, it likewise is done in a synchronous cycle, giving “synchronous cycle” the same general meaning?”

A. Yes; any one coil is always cut in for the same position of the motor shaft.”

Element 10 called for “means for rendering ineffective the electromotive force induced by said reversals.

This was referred to by the petitioner as the “trigger circuit”. It consisted of a distributor or mechanical switch on the end of the motor shaft which controlled a small electric current which operated a relay or electric magnetic switch which cut the armature coils of petitioners motor in and out at certain periods.

A similar device cut the armature coils in and out in the respondents device. The distributor on the end of the shaft was the same but instead of using a relay it used a three element vacuum tube. As in petitioners device a small current controlled by the distributor operates the vacuum tube making it cut the coils in at certain times. It is well known that this vacuum tube was invented by Lee DeForest in 1906 and was available as an equivalent for a relay before petitioners invention and application for patent in 1911.

As a matter of fact respondent claims its device was made under certain patents to Alexanderson many years later than petitioners patent. During the prosecution of the Alexanderson Patents certain claims were rejected. They call for a vacuum tube, referred to as a "valve" or "electronic valve." The patent office rejected the claims holding that the vacuum tube or "valve" in combination was only an equivalent of a mechanical switch in earlier combination patents.

The respondent appealed citing that ruling as error. The patent office was affirmed in the Board of Appeals and in the Court of Custom and Patent Appeals 21 U. S. P. Q. 164.

Returning again to a consideration of element 10 both the District Court and the Circuit Court of Appeals held that there was no such element in respondents device, but without any reference to or consideration of Prof. Dawes testimony as follows:

Speaking of respondents device Dawes testified Tr 392

Q. Isn't that what you do here? You mechanically cut coils in and out by the distributor at the end of the shaft?

A. No, we do it with tubes.

Q. Now, what causes the tubes to operate?

A. Well, the trigger voltage applied to the grid.

and at pages 526-527:

Q. Let me rephrase my question. The e.m.f. which we have spoken of as the e.m.f. of reversal in Engler's motor is Fig. 2 of the Engler patent is rendered ineffective because the coil is opened while that e.m.f. is generated; is that right?

A. That is right.

Q. Now, in the Engler motor, the distributor and relay cut the coil out and cut it in again at certain times, don't they?

A. Yes.

Q. And that I am going to tell you is what Engler refers to as his trigger circuit. You have understood, have you not, that that is what he meant by his trigger circuit?

A. Yes.

Q. In the Logan motor, the coil 2 is cut out because a phase of the alternating current reaches zero and the tube goes dead; is that right; and it won't pass any more current?

A. That is right.

And he further testified

Q. No; I mean the whole trigger circuit.

A. Yes, they both cause the coil to be connected at some definite time of the revolution of the shaft.

Q. That is right. So that, technically speaking, the distributor on the end of the Thyatron shaft and the distributor in the Engler motor, that is, No. 20 in Fig. 1 of the Engler patent, to distinguish it from the commutator, they are alike, they are *technical equivalents*, and serve the same purpose?

A. If you confine your question to closing the circuit—

Since the courts had found that there was no element 5 (reversible polarity), it is obvious that they would find

no e.m.fs. of reversal and consequently no means to eliminate e.m.fs. of reversal.

It is equally obvious that if there is an equivalent to element 5 in respondents device then favorable rulings must follow with respect to 9 and 10. Consequently the only issue is whether there is an equivalent to element 5 and the argument is directed to that point.

IV

Specification of assignment of errors intended to be urged.

The Circuit Court of Appeals erred in:

1. Affirming the decree of the District Court dismissing the plaintiff's complaint, and,
2. Failing and refusing to enter a decree of infringement and to order an accounting of damages and profits in favor of the plaintiff against the defendant.
3. Failing and refusing to find equivalents to all the elements of claim 8 in respondents device and more particularly in not reversing findings of Facts No. 13 and No. 14.
4. In ruling that substituted element used in respondents device could not be an equivalent because it was old.

V

Questions Raised

The questions sought to be reviewed are:

Was the Second Circuit Court of Appeals wrong in holding that a substituted element in a combination claim could not be an equivalent if it was old and well known prior to the invention in question, in view of

the cases in this Court; and should not the Second Court of Appeals have found equivalents and accordingly infringement on the matters in issue?

VI ARGUMENT

POINT 1

A substitute element is an infringing equivalent in a combination claim if it performs the same function and was known prior to the invention in question.

This rule has been firmly established in this Court for many years by a long line of cases:

In the leading case of *Seymour v. Osborne*, 78 U. S. 516, 556, the court said:

“Mere formal alterations in a combination in the letters patent however, are no defense to the charge of infringement, and the withdrawal of one ingredient from the same and the substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn, is a mere formal alteration of the combination if the ingredient substituted performs substantially the same function as the one withdrawn.”

In *Water Meter Co. v. Desper*, 101 U. S. 332, the court said:

“It is equally well known that if any of the parts is formally omitted, and is supplied by a mechanical equivalent, performing the same office and producing the same result, the patent is infringed.”

Paper Bag Patent Case, 210 U. S. 405;

Sanitary Refrigerator Co. v. Winters, 280 U. S. 31, 41, 42;

Winans v. Denmend, 56 U. S. 330, 342.

POINT 2

Element 5 Is Found In Respondents Device In Equivalent Form

The Trial Court opinion had said:

"The plaintiff argues that cutting out an armature coil in the Logan Motor (respondent's device) and cutting it in again a half revolution later is equivalent to Engler reversal (element 5). I have puzzled over this a great deal. I cannot see it. There is no reversal in the Logan Motor."

Professor Dawes had testified on cross examination that the elements were equivalent.

Tr. 473:

"Q. So that where Engler's claim says, 'a reversible field', insofar as the result is concerned, the cutting out of coil 2 and the cutting in of coil 3 (in respondents motor) gives an equivalent result, doesn't it?

A. Yes.

Q. So aside from patent law or the construction of patent law equivalents, the technical equivalent produces the same result and it is done for the same purpose?

A. I would say the result of producing rotation is the same."

There is no question of facts but a few words may clarify the meaning of the expression "of reversible polarity" (element 5).

An examination of Claim 8 shows that there are power windings (the armature coils or stationary coils); a magnetic member or members (the rotating field coils). Elements 5, 6 and 7 then read "of reversible polarity, relatively rotatable, and in mutually inductive relation."

This simply means as Dawes testified in cross examination in Tr. 404:

"You create a north pole on the stationary member and a south pole on the rotary member and then as the two poles attract each other you do something, *change one to the other*, so that continual motion results."

Like poles attract each other and unlike poles repel each other.

The above testimony simply means that you create unlike poles, that is a north pole and a south pole, in the armature and field until they attract each other. Then, you change one of them so that they repel each other and continue rotation. Both parties did this in such a way as to avoid reversal of the power current in the armature and thus obtained "homopolar" motors.

Professor Dawes made this clear in cross examination testifying as follows:

"And the first step that each one does is release a coil—the Logan motor, one of the armature coils; and Engler's motor releases the field coil;" (Tr. 455).
 "In the Engler motor, he puts the same coil back in * * * and reverses the direction of the current," (Tr. 450).

"In the Logan motor, we put in another coil one-third away around the circle;" (Tr. 449).

In the Logan motor the same coil is cut back in the same direction more than one-half of a revolution later. In Engler it is put back immediately but with the current reversed but Professor Dawes agrees that:

"If we waited a half a revolution before we put the Engler coil in, we could put it back in the same direction."

To explain this we might consider a person riding on a merry-go-round. He can get to the other side of the merry-go-round, that is reverse his position by walking across the merry-go-round while it is turning, or, he can step off to the ground and step on again when the merry-go-round has turned a half revolution.

We may consider a person looking at a picture. He can see the other side of the picture either by turning the picture around or by holding the picture still and walking around to the other side.

There is no more difference than that between the two machines involved.

Cutting the coils in and out periodically as the respondent does changes or reverses the polarity of the armature poles or otherwise it would be impossible for the motor to run. The Court of Appeals on rehearing stated that it recognized the equivalency of function though for some reason not appearing in the record the court chose to call it "intermittent polarity" rather than "reveral polarity."

Thus there is no question of fact on the equivalency of element 5, the Court of Appeals simply having failed to follow the rule of this court.

POINT 3

Respondents Device Has A Trigger Circuit (element 10), Which Eliminates e.m.fs. of Reversal

The Court of Appeals said on rehearing that "any stray current in the defendants motor is simply ignored." If by stray current the Court meant induced e.m.fs., they are ignored in respondents device the same as in petitioners device, that is, by cutting out the armature coils periodically.

This reversal of polarity in the armature was accompanied by e.m.fs. which were eliminated by cutting the coils out and Dawes so testified on cross examination.

Tr. 513-514:

Q. Then let me begin over. You have said in the armature coil of Engler that there is a transformer voltage when you reverse the polarity of the field coil; is that right.

A. That is right.

Q. And because the field coil is in motion at that time, you also have some slight speed voltage effect also?

A. That is right.

Q. I say the same is true with respect to coil 2? Or I am asking you.

Mr. Neave: Coil 2 in what?

Mr. Ring: Coil 2 in the Thyatronmotor, the Logan motor.

Q. From the time you start to cut it out until the time it is cut in effectively again, you have had both a transformer voltage and a speed voltage induced in that coil, whether they are in the same direction or opposed to each other?

A. That may be true, but the transformer voltage is not due to any effect of the field.

Q. All right; I will accept that answer. Whatever it is due to, it is there, isn't it?

A. I prefer to call it an electromotive force of self-induction. But it is due to changing of the flux in a stationary coil.

Q. It is a transformer voltage, nevertheless, isn't it?

A. That is right.

Q. Now, in the Engler coil, that combination of speed and transformer voltage is rendered ineffective by what he calls a trigger circuit, that is, the dis-

tributor 20 which operates the relay 14; isn't that right?

A. That is right.

and at Tr. 521:

Q. You also agree that Engler could accomplish the same result, though perhaps only half as efficient, if he cut out his field coil and put it back in again a half a revolution later in the same direction instead of reversing it; is that right?

A. Oh, he could do that.

Q. So the expression "e.m.fs. of reversal", in that expression the "of reversal" does not describe the e.m.fs.; it means, does it not, that two successive e.m.fs. in the same direction were brought about by the reversal of the coil?

A. That is right.

and at Tr. 474-475:

Q. So that Engler's claim says "a reversible field" insofar as the result is concerned the cutting out of the coil 2 and the cutting in of coil 3 (in Logan motor) gives an equivalent result, doesn't it?

A. Yes.

Q. Produce the same. So aside from patent law or the construction of patent law equivalents, the technical equivalent produces the same result and it is done for the same purpose?

A. I would say the result of producing rotation is the same.

Q. That is what I mean, of helping to produce rotation and preventing it from being locked in one position?

A. That is right.

Conclusion

All the facts in this case are clearly established by the cross examination of appellees expert.

"A case that can be made out in all its elements by cross-examination of opposing witnesses is a strong case."

Eibel Process Co. v. Minnesota, 261 U. S. 45, 53.

The courts below have erred in denying infringement on erroneous rulings of law principally in holding that a substitute element is not equivalent if it was old. In such conclusions they have assumed that to hold an old substitute to be an equivalent would be to give a new patent on an element. This ignores the fact that the patent is on the entire combination and not on any element.

The court is urged to grant this petition because the ruling is of great public importance. This court frequently speaks of protecting public interest. The public includes the great army of inventors who have created industrial America and they should be protected against exploitation by the great and powerful corporations. There is far more danger to the public from a monopoly of a great corporation than from an individual patent.

The decisions of this and other courts have from time to time suggested a fundamental opposition to patents in the belief that they were basically undesirable monopolies. The court is urged to consider another point of view. The greatest fund of scientific knowledge and development available for the public lies in the nearly two and one-half million patents divided and sub-divided into classes. There can be no doubt that patents, both by virtue of the knowledge made available for others at low cost, and the inducement to inventors to achieve new re-

sults have contributed greatly to the industrial achievements of the past several years. The writers of the Constitution and the Congress wisely realized this in making the written law.

President Roosevelt realized this when in a letter to the Senate Committee on patents, according to the New York Times of April 14, 1942 he said that in this country

“patents are the key to our technology, technology is the key to production and production is the key to victory.”

The few cents paid in royalties or damages for patent infringement, even though passed on eventually to the public, is a small price for the great achievements of a successful patent system.

To sustain a patent may at first seem a burden on the public but there are endless cases which show the eventual great reward to the public by sustaining patents. It is impossible to say how much of our great industrial achievement would have resulted even though we had no patent system but it is sound to believe that much is due to the patent system. There are three strong reasons for this suggestion.

First: The hundreds of thousands of patent applications show that as many inventors are striving for new scientific results inspired in part by the hope of obtaining a patent.

Second: Millions of patents available at ten cents a copy make the most up-to-date developments available to the public at low cost long before it is available in text books.

Third: To sustain a patent inspires those affected thereby to strive for new results to avoid infringement.

It is urged that the simple issue of this case is of great public importance and a certiorari be granted to review and clarify the matter.

Respectfully submitted,

CARL E. RING,
Attorney for Petitioner.

New York City
March 31, 1945.





UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT

No. 250—October Term, 1943.

(Petition filed December 8, 1944

Decided December 28, 1944.)

RICHARD A. ENGLEB,

Appellant,

—against—

GENERAL ELECTRIC COMPANY,

Appellee.

Before :

L. HAND, SWAN and CHASE,

Circuit Judges.

On Petition for Rehearing.

Per Curiam:

Of course two poles were created every time one of the coils of the appellee's armature was energized and these poles were opposite in value as well as opposite each other in space across the armature. That was taken to be self evident. This change in pole values around the circle is what the appellant still argues is an infringing reversal of polarity in the armature and he insists that we were wrong in saying there was no reversal of polarity anywhere in the appellee's machine. While we still think it should instead be called, for want of a better term, intermittent

polarity, we are not disposed to put decision upon any verbal distinction in this respect between the patented machine and that of the appellee.

As we have already said the accused machine has "only the successive cutting in and cutting out of the armature coils in the stator which enables the rotor of the appellee's motor to revolve, and merely in the sense that revolution of the rotor is essential to the operation of any electric motor, that does accomplish what the reversal of polarity in the field does for the patented machine." Thus the equivalency in function was recognized but we were unable to treat this as enough to come within the range of equivalents to which the patentee was entitled because, as we pointed out, what we called intermittent polarity was old in the art. We still are unable so to broaden the claim for the same reason, for whether the creation of poles of opposite value around the defendant's armature ought to be called a reversal of polarity or not it is nevertheless an old feature as to which the appellant could not, and did not, obtain any monopoly when his patent was granted. So he must be limited in his range of equivalents at least enough to exclude that.

Nor has the defendant any "means for rendering ineffective the electromotive force induced by said reversals." Any stray current in the defendant's motor is simply ignored. What the appellant calls his trigger circuit has no counterpart in the defendant's motor whether he is right in saying that the defendant's distributor plus the thyratrons which cooperate to cut the coils in and out should or should not be called a trigger circuit. Calling that cooperation one name or another does not change the fact that it does not provide the means for rendering ineffective any electromotive force induced by any reversals.

As neither of these features to which the combination was tied in the claim allowed are to be found in the ac-

cused machine, the latter cannot be held to infringe without in effect rewriting the claim. That we have no right so to do cannot be disputed. We can enforce only the monopoly the patentee secured when his claims were allowed. If that was not as broad as it should have been, his failure to succeed in this suit must be attributed to the failure to get years ago that to which he was entitled in the Patent Office and not to any denial of his rights at this time.

Petition denied.



(9)

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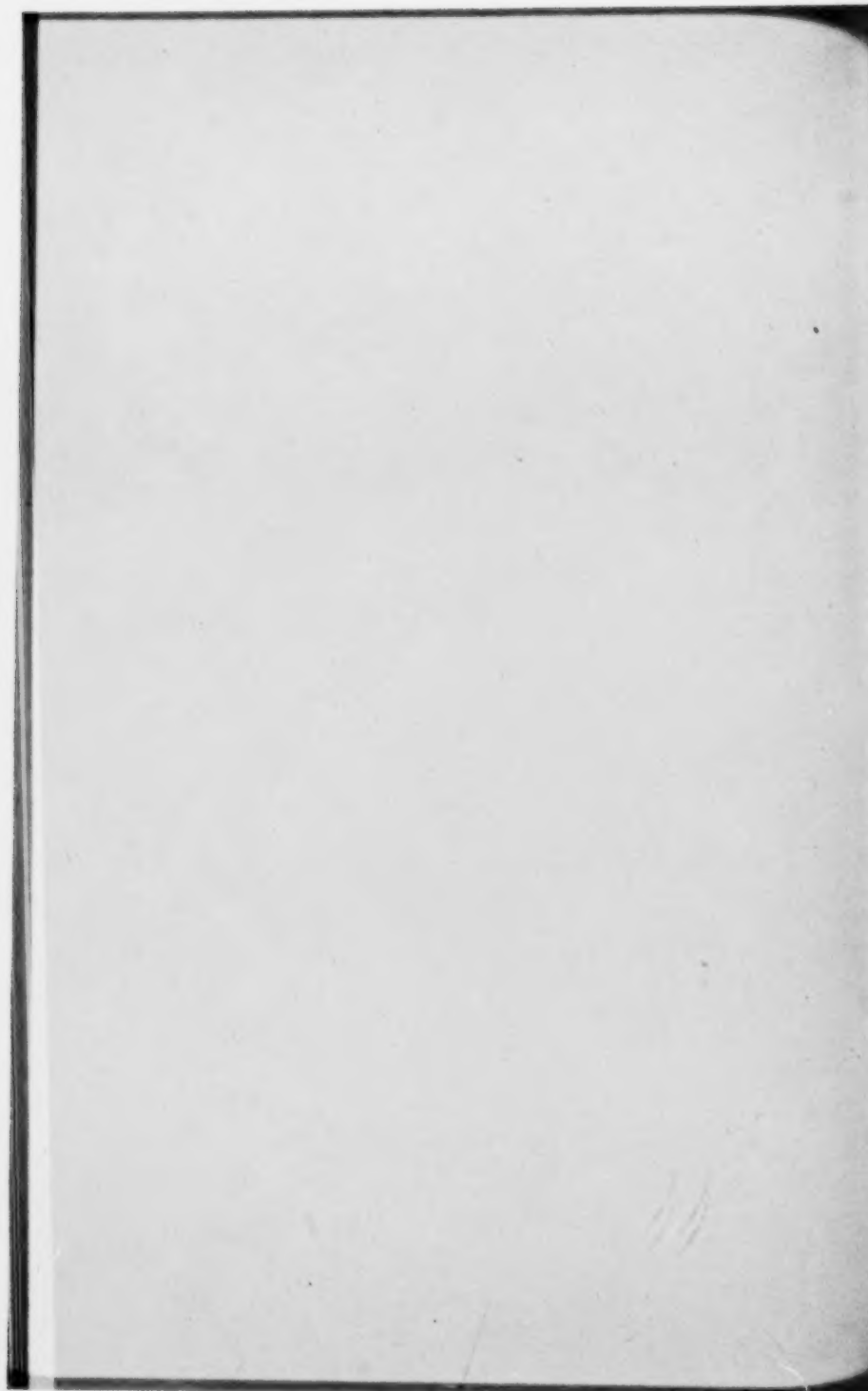
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GENERAL ELECTRIC COMPANY, *Respondent.*

RESPONDENT'S BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI

ALEXANDER C. NEAVE,
Counsel for Respondent.

April 1945



Supreme Court of the United States

OCTOBER TERM, 1944

No. 1100

RICHARD A. ENGLER,
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v.

GENERAL ELECTRIC COMPANY,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

In this case the District Court and the Court of Appeals for the Second Circuit concurred in holding that the patent in suit was not infringed. Neither court found it necessary to pass upon the defense of invalidity.

There is no conflict of decision: this is the only suit upon this patent, which expired during the litigation.

There is no important question of law and no conflict of law: the courts below applied the well-known principles of patent law and both courts found no infringement.

There is no question of commercial importance: the alleged infringement consisted of only one machine made by respondent, and as admitted in the petitioner's brief (p. 5) petitioner never built his patented machine.

Neither the petition nor the supporting brief sets forth any reason for review by this Court other than that neither of the courts below would accept petitioner's argument of infringement based upon the doctrine of equivalency. That

is an insufficient basis for the granting of a writ of certiorari. In *Magnum Import Company, Inc. v. Coty*, 262 U. S. 159, 163, Mr. Justice Taft stated:

“The jurisdiction [to bring up cases by certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing.”

It is evident from the opinions below that both courts considered the petitioner's patent with great care to determine the invention there disclosed and claimed, and concluded unanimously that the invention, if any, was not to be found in respondent's device. If any invention at all was made, it resided in reversing the polarity of the rotor magnet of the device and in stifling certain unwanted voltages caused by these reversals. A device which embodied other means for obtaining motor action or which did not produce and stifle these unwanted voltages did not infringe, and could not infringe through the doctrine of equivalents or otherwise, for if those features were not used, nothing of the petitioner's was used. He did not invent motor action, but only suggested a device of specific construction.

This is clearly established by the District Court's Findings of Fact 7 to 13 inclusive:

“7. In all of the eight claims of the Engler patent the dominant and characterizing features of each claim are the reversal of the polarity of the rotor magnet and the rendering ineffective the voltages induced in the armature winding caused by such reversal.

8. There is not found in the Logan Motor [respondent's device] magnetic members of reversible polarity (5), means for reversing the polarity in a synchronous cycle (9), means for rendering ineffective the electromotive force induced by said reversals (10).

9. Plaintiff urged infringement on the ground that the Logan Motor has equivalents of the said

elements 5, 9 and 10; that the Logan Motor reached the same result as the device contemplated by Engler and does it by a combination of elements, each of which is the same or equivalent.

The two devices do accomplish the same result, i.e., cause rotation, which produces electric force or working power but each accomplishes this in a substantially different way.

10. The specification and claims 1 through 8 inclusive of the Engler patent are limited to a particular mode of operation. By this mode of operation, (1) the rotating electric field member of the machine is reversed in polarity every half revolution by means of a commutator 10 mounted on the shaft of the machine, (2) the reversal of the polarity of the rotating field member induces an unwanted and useless voltage in the armature winding, and (3) this voltage caused by the field reversal is rendered ineffective either by short circuiting the armature winding as in Fig. 1, or by open circuiting the armature windings as in Fig. 2 by means of an electromagnetic switch. This is not found in the Logan Motor either specifically or by equivalents.

11. The distinguishing element in the Engler motor as evidenced by claim 8 is a reversal of the polarity of the rotor field magnet; the rotor polarity is reversed every half revolution. There is no such thing in the Logan Motor.

The Logan Motor operates with no reversal of current either in the winding of the armature (stator), or in the winding of the rotating member the rotor. The Engler motor operates because he reverses the current in the field winding in the rotor. This is absolutely essential to the Engler Motor. It is not in the Logan Motor.

12. The cutting out of an armature coil in the Logan motor and cutting it in again a half of a revolution later is not equivalent to the reversal in the Engler machine.

13. There is nothing in the Logan Motor equivalent to elements 5 and 9 of the Engler patent."

The Court of Appeals agreed with these findings, stating (144 F. (2d) 191, 194, 195):

" * * * Both [devices] prevent 'locking'. But there the similarity ends. And when the appellant claimed only a combination which included means for reversing polarity, and it appears that that was the *sine qua non* of his invention, if he made any at all, proof which shows that the defendant constructed an electric motor which ran with no reversal of polarity at all fails to prove infringement."

" * * * That intermittent polarity is not here the equivalent of continuously reversing polarity is made clear by the fact that the latter is a limitation in a patent claim for a device which as disclosed in the specifications must have such continued polarity constantly reversing to operate at all. It is to be taken for granted that the patentee meant what he said when he limited his claims in plain words to that essential feature of his machine. He then made his bargain and now must abide by it. *Ajello v. Pan-American Airways Corp.*, 2 Cir., 128 F. 2d 196. It will not help his cause as he now argues, to say that he might have prevented locking by successively cutting out and cutting in armature coils to make polarity non-existent periodically and so obviate locking by means of intermittent polarity. He did not secure patent claims broad enough to cover generally the prevention of the locking of the field and the armature in an electric motor. That, per se, was not new and accomplishing it in a way like that the appellee employed by cutting out and later cutting in armature coils was itself very old, as the *Leyser's* German Patent No. 23,880, granted in 1883, well shows."

With respect to the so-called "trigger-circuit", the District Court's Finding of Fact 14 was as follows:

"14. There is not present in the Logan Motor either specifically or by equivalence 'means for rendering ineffective the electromotive force induced by said reversals'."

The Court of Appeals agreed with this finding, stating (144 F. 2d 191, 193):

“Neither the so-called trigger circuit nor anything which accomplished the same result is present in the accused motor.”

The District Court found as its Conclusion of Law 4:

“Claims 1 through 8, inclusive, of the Engler patent 1,492,972 are not infringed by defendant’s Logan Motor. These claims cannot be read so broadly as to be infringed on the basis of any proper application of the doctrine of equivalents.”

The Court of Appeals stated (144 F. 2d 191, 195):

“The trial judge was quite right when he held that no infringement of the claims in suit had been shown.”

The Court of Appeals again gave careful consideration to the case on petitioner’s petition for rehearing, which it denied with an opinion reaffirming its decision of non-infringement (146 F. 2d 723).

The case was correctly decided below, both courts concurring in holding that respondent had not infringed the patent in suit. Petitioner has advanced no reason to warrant a review by this Court.

We respectfully submit that the petition should be denied.

ALEXANDER C. NEAVE,
Counsel for Respondent.

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